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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Werner Blohm, Harald Sikora and
Adrian Beining

Serial Number

10/008,998

Filing Date:

December 4, 2001

For:

METHOD OF MEASURING THE
DIAMETER OF AN ELONGATED
ARTICLE OF A CIRCULAR CROSS
SECTION

Examiner:

Richard A. Rosenberger

Group/Art Unit:

2877

Box Amendments
Assistant Commissioner of Patents
Washington, D.C. 20231

Docket:48619/265797

RESPONSE

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This Response is submitted in response to the Examiner's Action mailed February 22, 2002 ("Examiner's Action"). A petition for two month extension of the time to respond is submitted herewith.

Summary

This application is a continuation of a parent application. Applicants on filing this application cancelled all claims pending in the parent application and introduced a new set of 56 claims, each with additional limitations and requirements not contained in the previous claims. The preliminary

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amendment which introduced these new claims contained more than 9 pages of remarks which pointed out with great care and effort many differences between what is contained in the new claims and the two references previously cited by the Examiner, and the many other reasons the new claims are patentable. Yet, the only basis in the Examiner's Action for rejecting these new claims is the identical, cursory paragraph found in the previous action in the parent application which applied to old claims 1 - 24. That paragraph applies the same two references as the previous action and uses the same language to conclude that all claims are obvious. That paragraph utterly fails (among other things) to:

- (1) establish a prima facie case of obviousness,
- (2) address claim elements missing in the references,
- (3) make the effort to cite and apply any other references that purportedly disclose such elements;
- (4) point out any portion of either reference that suggests they should be combined;
- (5) address the fact that the Ring reference expressly teaches away from the French reference; or
- (6) provide any reasoning or analysis whatsoever that had not been applied to the different, old claims.

Accordingly, the following recasts Applicants' remarks in form for appeal of this matter. Applicants respectfully request that the Examiner either